

REMARKS

Claims 1, 12 and 23 are amended herein. Claims 1-31 remain pending in the present application. No new matter has been added.

Claim Rejections - 35 U.S.C. §112

The present office action states that Claims 1-31 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the presence of “Macintosh Operating System” is not proper.

Applicants respectfully disagree with the properness of the maintained rejection. The only actual citation supporting the rejection is section 2173.05(u) of the MPEP.

Applicants respectfully submit section 2173.05(u) of the MPEP states, “The presence of a trademark or trade name in a claim **is not**, per se, improper under 35 U.S.C. § 112, second paragraph.” (emphasis added)

Thus, Applicants submit the utilization of a reference to MPEP 2173.05(u) in the present Office Action does not constitute a proper rejection. That is, since MPEP 2173.05(u) clearly provides that the presence of a trademark or trade name in a claim **is not, per se, improper** under 35 U.S.C. § 112, second paragraph, Applicants respectfully submit the prima facie case for a rejection under 35 U.S.C. § 112, second paragraph, has not been met.

Further, Applicants respectfully point out that MPEP 608.01(v)(I) clearly provides that if a trademark having a fixed and definite meaning it constitutes sufficient identification. Moreover, the USPTO has issued more than 50+ patents; and has more than 60+ applications that include the term “Macintosh” as a description of a fixed and definite description of the Macintosh operating system; including, for example, 5,386,493; 6,023,558; 7,089,300; 5,621,906; 7,130,888; 6,298,446; 20070005663; 20020035612.

MPEP 608.01(v)(I). < TRADEMARKS

“However, if the product to which the trademark refers is set forth in such language that its identity is clear, the examiners are authorized to permit the use of the trademark if it is distinguished from common descriptive nouns by capitalization. If the trademark has a fixed and definite meaning, it constitutes sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention. In that event, as also in those cases where the trademark has no fixed and definite meaning, identification by scientific or other explanatory language is necessary. *In re Gebauer-Fuelnegg*, 121 F.2d 505, 50 USPQ 125 (CCPA 1941).” (emphasis added)

MPEP 608.01(v)(I). < TRADEMARKS

“Although the use of trademarks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected. Trademarks should be identified by capitalizing each letter of the mark (in the case of word or letter marks) or otherwise indicating the description of the mark (in the case of marks in the form of a symbol or device or other nontextual form). Every effort should be made to prevent their use in any manner which might adversely affect their validity as trademarks.” (emphasis added)

For these additional reasons, Applicants respectfully submit the rejection of Claims 1-31 under 35 U.S.C. § 112, second paragraph, based on the presence of the trademark “Macintosh Operating System” is improper and should be withdrawn as Macintosh operating system or MAC O/S has a fixed and definite meaning and there is no other term known to the Applicants which will provide as sufficient identification of the operating system characteristics as the term “Macintosh Operating System”.

Claim Rejections - 35 U.S.C. §102

Claims 1, 5-7, 9-13, 16-24 and 26-31

The present office action states that Claims 1, 5-7, 9-13, 16-24 and 26-31 are rejected under 35 U.S.C. § 102(c) as being anticipated by Wiser et al. (6,385,596). Applicants have reviewed the cited reference and respectfully submit that the embodiments of the present invention as recited in Claims 1, 5-7, 9-13, 16-24 and 26-31 are not anticipated by Wiser et al. for the following reasons.

Applicants respectfully submit that currently amended Claim 1 (and similarly Claims 12 and 23) includes the feature “A method for preventing unauthorized recording of media content on a Macintosh operating system comprising:

registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism providing stand alone functionality and operation on said client system, said compliance mechanism comprising:

a framework for validating said compliance mechanism on said client system; and

a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system; and

preventing decryption of said media content on said client system having said Macintosh operating system operating thereon **if a portion of said compliance mechanism is invalidated.**” (emphasis added).

According to the Federal Circuit, “[a]nticipation requires the disclosure in a single prior art reference of each claim under consideration” (W.L. Gore & Assocs. v. Garlock Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983)). However, it is not sufficient that the reference recite all the claimed elements. As stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention “arranged as in the claims” (emphasis added; Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984)).

Applicants have reviewed Wiser et al. and do not understand Wiser et al. to anticipate the feature, “registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism

providing stand alone functionality and operation on said client system, said compliance mechanism comprising: a framework for validating said compliance mechanism on said client system; and a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system” (emphasis added).

Applicants understand Wiser to teach a client-server architecture. Specifically, as shown in Figure 1 and described at least at Column 5,. Applicants understand the system overview to provide a music distribution center 124 which operates with any number of client systems 126.

Music Distribution Center 124 includes a content manager 112, at least one delivery server 118 and an HTTP server 122. The content manager 112 maintains a media information database 106, a master media file system 120 and a transaction database 130. Client system 126 includes a media player 116 and a web browser 128.

Thus, as Applicants understand Wiser to teach a client portion and a server portion of a compliance system; Applicants respectfully assert that Wiser does not disclose each element of the claimed invention “arranged as in the claims.” Including the feature, “said compliance mechanism providing stand alone functionality and operation on said client system, said compliance mechanism comprising: a framework for validating said compliance mechanism on said client system; and a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system” (emphasis added).

For this reason, Applicants respectfully assert that the rejection of Claims 1, 12 and 23 under 35 U.S.C. § 102(a) is overcome. In addition, Applicants also submit Claims 5-7, 9-11, 13, 16-22, 24 and 26-31 are also allowable as being dependent on allowable base Claims.

With respect to Claims 12 and 23, Applicants respectfully submit that Claim 12 (and similarly Claim 23) clearly recites the feature “disabling output of said media

content on said client system having said Macintosh operating system operating thereon if a portion of said compliance mechanism is invalidated.” Applicants have reviewed Wiser et al. and do not understand Wiser et al. to anticipate disabling output. In contrast, Applicants understand Wiser et al. to teach the media player being unable to decrypt the media if the passport is not valid or existing.

Applicants respectfully submit that there is a large and distinct difference between a media player being **unable** to decrypt media and a media player that is able to play media but the **output on the client system being disabled** (emphasis added).

For this reason, Applicants do not understand Wiser et al. to anticipate the features of Claims 12 and 23. As such, Applicants respectfully state that Claims 12 and 23 are allowable.

With respect to Claims 5-7, 9-11, 13, 16-22, 24 and 26-31, Applicants respectfully state that Claims 5-7, 9-11, 13, 16-22, 24 and 26-31 depend from the allowable Independent Claims 1, 12 and 23 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 5-7, 9-11, 13, 16-22, 24 and 26-31 are also allowable as pending from allowable base Claims.

Rejection under 103(a)

Claims 2-4, 14-15 and 25

In the Office Action, the Examiner rejected Claims 2-4, 14-15 and 25 under 35 USC 103(a) as being unpatentable over Wiser et al. and further in view of Curran et al. (4,525,599). Applicants have reviewed the cited reference and respectfully submit that the present invention is not rendered obvious over Wiser et al. in view of Curran et al. for the following rationale.

Applicants respectfully submit that Claim 1 (and similarly Claims 12 and 23) includes the feature “A method for preventing unauthorized recording of media content on a Macintosh operating system comprising:

registering a compliance mechanism on a client system having said Macintosh operating system operating thereon, said compliance mechanism providing stand alone functionality and operation on said client system, said compliance mechanism comprising:

a framework for validating said compliance mechanism on said client system; and

a multimedia component opened by said framework, said multimedia component for decrypting said media content on said client system; and

preventing decryption of said media content on said client system having said Macintosh operating system operating thereon **if a portion of said compliance mechanism is invalidated.**" (emphasis added).

For the reasons previously provided herein, Applicants respectfully submit that Claims 1, 12 and 23 are not rendered obvious by Wiser et al. Moreover, the combination of Curran et al. does not overcome the shortcomings of Wiser et al.

That is, Applicants do not understand Wiser et al. alone or in combination with Curran et al. to teach or render obvious the features of Claims 12 and 23, including, "said compliance mechanism providing stand alone functionality and operation on said client system."

As such, Applicants respectfully submit that Claims 1, 12 and 23 are presently allowable.

With respect to Claims 2-4, Applicants respectfully submit that Claims 2-4 depend from the allowable Claim 1 and recite further features of the present claimed invention. Therefore, Applicants respectfully state that Claims 2-4 are allowable as pending from an allowable base Claim.

With respect to Claims 14-15, Applicants respectfully submit that Claims 14-15 depend from the allowable Claim 12 and recite further features of the present claimed

invention. Therefore, Applicants submit that Claims 14-15 are allowable as pending from an allowable base Claim.

With respect to Claim 25, Applicants respectfully submit that Claim 25 depends from the allowable Claim 23 and recites further features of the present claimed invention. Therefore, Applicants submit that Claim 25 is allowable as pending from an allowable base Claim.

Claim 8

The present Office Action rejects Claim 8 under 35 USC 103(a) as being unpatentable over Wiser et al. in view of official notice. Applicants have reviewed the rejection of record and respectfully submit that the present invention is not rendered obvious over Wiser et al. in view of Official Notice for the following rationale.

Applicants respectfully submit that the present Office Action has provided inadequate support of a finding of Official Notice.

The “assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support” (MPEP 2144.03(A); *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)). In particular, “[i]f such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge” (MPEP 2144.03(B); see *In re Soli*, 317 F.2d 941, 946, 37 USPQ 797, 801 (CCPA 1963); see also *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943)).

“It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection is based” (emphasis added; MPEP 2144.03(E); See *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); *In re Ahlert*, 424 F.2d 1088, 1092, 165 USPQ 418, 421 (CCPA 1970)).

The Office Action offers security programs that maintain a list of possible viruses and motivation to prevent malware from executing on the computer.

However, Applicants respectfully submit the “bad boy list” as Claimed is clearly defined in the specification as software that a user would purposely download, activate and utilize for purpose of circumventing digital rights. Further, Claim 8 does not teach preventing of any items on the bad boy list from executing on the computer.

Accordingly, Applicants respectfully that the Examiner provide adequate evidence in the form of an affidavit in support of the finding of Official Notice, in accordance with 37 CFR § 1.104(d)(2).

In addition, Applicants respectfully submit that Claim 8 depends from the allowable Claim 1 and recites further features of the present claimed invention. Therefore, Applicants respectfully state that Claim 8 is allowable as pending from an allowable base Claim.

CONCLUSION

Based on the arguments presented above, Applicants respectfully assert that Claims 1-31 overcome the rejections of record, and therefore, Applicants respectfully solicit allowance of these Claims.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,
Wagner Blecher LLP

Date: October 3, 2008

/John P. Wagner, Jr./

John P. Wagner, Jr.
Reg. No. 35,398

WESTRIDGE BUSINESS PARK
123 WESTRIDGE DRIVE
WATSONVILLE, CALIFORNIA 95076
(408) 377-0500